

REMARKS

Status of Claims:

Applicant respectfully requests reconsideration of the present application in view of the reasons that follow.

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

Claim 1 and 52 are currently amended. Claims 24-48 were previously cancelled without prejudice or disclaimer. Claims 1-23 and 49-54 are present for examination.

Claim Rejections:

1. Claims 1-11, 14-23 and 49-54 have been rejected under 35 U.S.C. 103 (a) as being unpatentable over Barry (U.S. Patent Application No. US2002/0077592 A1) (hereinafter Barry), in view of Adair et al. (U.S. Patent No. 6,211,904 B1) (hereinafter Adair).

2. Claims 12-13 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Barry in view of Adair in further view of Silver (U.S. Patent No. 6,442,413) (hereinafter Silver).

3. Claims 4, 19-23 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Barry in view of Adair.

Each of those rejections is respectfully traversed. Applicant requests reconsideration of the present application in view of the following remarks.

Applicant's Argument Traversing the Rejections:

Independent claim 1, as amended, recites a method for mitigating restenosis at a trauma site at which a stent is located within the vasculature comprising:

- positioning a catheter adjacent the trauma site;
 - extending a sensor through a lumen in the catheter and through the stent to a position located outside of the catheter and outside of the stent; and
 - delivering a restenosis mitigating drug to the trauma site through the catheter;
- wherein the sensor comprises an analyte sensor, physiological parameter sensor, biological parameter sensor, biochemical parameter sensor, or chemical parameter sensor.

As explained in the response to the prior Office Action, and as confirmed by the Examiner, Barry does not disclose a method having the above-noted features including “positioning a catheter adjacent the trauma site; extending a sensor through a lumen in the catheter and through the stent to a position located outside of the catheter and outside of the stent, and delivering a restenosis mitigating drug to the trauma site through the catheter.” More specifically, the Examiner states that “Barry discloses the claimed invention except for the step of extending the sensor through the stent to a position located outside of the catheter and outside of the stent.” The Examiner states that “Adair et al. teaches that is known to use the step of extending the sensor through the stent.” The Examiner further states that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Barry with the step of extending the sensor through the stent to a position located outside of the catheter and outside of the stent. The Applicant respectfully disagrees with the above statements made by the Examiner, because of the following reasons.

Adair does not disclose a sensor being extended wherein the sensor comprises an analyte sensor, physiological parameter sensor, biological parameter sensor, biochemical parameter sensor, or chemical parameter sensor. Adair discloses a microendoscope that clearly does not

comprise any of the above mentioned types of sensors, and instead it is a device that just provides an image. For example, see Column 19, lines 24-33, that states “Because of the small size of the microendoscope, it can be placed inside the catheter tube 292 so to provide the surgeon a view of the interior wall of the artery. In operation, the distal end 16 of the tubular portion may protrude beyond the distal end of the catheter tube 292 in order to provide an image to the surgeon as the stent placement catheter is traversed through the artery or other bodily passages on the route to the artery.”

Additionally, insofar as the combination proposed by the Examiner requires a replacement of Barry’s sensor with Adair’s microendoscope, the Examiner’s proposed combination would be inoperable and, as such, the cited references teach away such combination. For example, if Barry’s device were to be modified such that Barry’s sensor is replaced by Adair’s microendoscope, then a primary function of Barry would become inoperable because the purpose of the sensor in Barry was to sense the temperature inside the stent. See Paragraph 0089 of Barry which states “a temperature sensor 255 connected through the conductors 251 to the rf heating source 252 provides a feedback control signal to accurately regulate the temperature of the liquid 48.” Replacing the sensor with a microendoscope which is outside the stent, will prevent Barry from operating as a temperature sensor, as it was intended. This is because Adair’s microendoscope does not sense temperature. Furthermore, Adair’s teaching of locating the microendoscope outside of the stent counters Barry’s expressed function of detecting temperature inside the stent. The Examiner’s proposed combination would render Barry’s device inoperable for its intended purpose.

According to re Gordon, 733, F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984), when the Examiner proposes a combination that makes a prior art reference inoperable for its intended purpose, the resulting inoperable prior art reference may be considered to teach away from the proposed combination, i.e., not to teach the combination, thereby supporting a showing of non-obviousness. Here, as shown above, the proposed combinations would make the Barry reference inoperable, and as such, Barry teaches away from the proposed combination, and

consequently, the Barry reference can not serve as a predicate for a prima facie case of obviousness.

The rejection of claim 1 is therefore, respectfully traversed. Claims 2-23 and 49-51 are dependent on claim 1 and are believed to be allowable over the Barry reference at least for reasons as discussed above with respect to claim 1. While the Examiner combined the Silver patent with the Barry and Adair references to form the rejection of claims 12 and 13, the Silver patent does not address the above-noted distinctions over the Barry reference.

The rejection of claim 52 is respectfully traversed for reasons similar to those discussed above with respect to claim 1. In particular, claim 52 recites a method that includes, among other features, “extending a sensor through the catheter and through the stent to a position located outside of the catheter and outside of the stent, wherein the sensor comprises an analyte sensor, physiological parameter sensor, biological parameter sensor, biochemical parameter sensor, or chemical parameter sensor.” As described above with respect to claim 1, neither Barry nor Adair, individually or in combination teach, suggest, motivate or render predictable extending a sensor through a catheter to a position located outside of the catheter, wherein the sensor comprises an analyte sensor, physiological parameter sensor, biological parameter sensor, biochemical parameter sensor, or chemical parameter sensor. The rejection of claim 52 is therefore, respectfully traversed. Claims 53 and 54 are dependent on claim 52 and are believed to be allowable over the Barry reference at least for reasons as discussed above with respect to claim 52.

Due to the aforementioned differences between Barry, Adair and the current invention, the Examiner has failed to meet the legal standard for showing obviousness under 25 U.S.C. 103(a) for claims 1-23 and 49-54.

Conclusion:

Applicant respectfully submits that in view of the foregoing remarks the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date: December 18, 2007

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